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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/076,554	02/19/2002	Yumiko Seki	500.41210X00	1472

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MATTINGLY, STANGER, MALUR & BRUNDIDGE, P.C.
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SUITE 370
ALEXANDRIA, VA 22314

EXAMINER

VIG, NARESH

ART UNIT	PAPER NUMBER
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3629

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/22/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/076,554

Applicant(s)

SEKI ET AL.

Examiner

Naresh Vig

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-6 and 8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-6 and 8 is/are rejected.
- 7) ☒ Claim(s) 1 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This is in reference to response received 04 December 2006. Claims 1, 3 – 6 and 8 are pending for examination.

Response to Arguments

Applicant's arguments and concerns for amended claims are responded to in response to pending claims.

Claim Objection

Claim 1, line 4 recites the limitation "the method comprising steps operable on the computer of:" Examiner reads the limitation as "the method comprising steps operable on the computer for:". Appropriate correction is requested.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 3, 6 and 8 are rejected under 35 U.S.C. 112, second paragraph, as being vague and indefinite. For example:

Claim 1, lines 17 – 18, recite the limitation “examining said application documents to check whether any of said application documents include an item which violates examination criteria”. Applicant has not positively whether the examining is done to the user selected country or any country.

Claim 3 recites the limitation “acquiring information on documents which have been applied in a certain country, and information on documents which have accepted permission from said country as a result of examinations after application; and assisting in preparing an application for another country with reference to said information on the documents. Applicant has not positively claimed the limitation of certain country, is it same as “another country”, some other country which does not have any thing to do with “another country” for which document has to be prepared, etc.

Claim 6, lines 17 – 18, recite the limitation “means for examining said application documents to check whether any of said application documents includes an item which violates examination criteria” . Applicant has not positively whether the examining is done to the user selected country or any country.

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Claim 8, recite the limitation "means for acquiring information on documents which have been applied in a certain country, and information on documents which have accepted permission from said country as a result examinations after application, wherein said means for assisting in preparing application documents prepares an application for another country with reference to said information on the documents". Applicant has not positively claimed the limitation of certain country, is it same as "another country", some other country which does not have any thing to do with "another country" for which document has to be prepared, etc.

Claim Rejections – 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3 – 4, 6 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over ZipForm (document labeled as Information on ZipForm) in view of Gajraj US Publication 2002/0002566 and further in view of Broadbent et al. US Patent 6,904,412 hereinafter known as Broadbent.

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Regarding claims 1 and 6, ZipForm teaches application preparation assisting method and system operating a computer to assist in preparing an application for making a document-based application to a public organization [ZipForm page 11 – 13].

ZipForm teaches:

Even though ZipForm does not explicitly teaches acquiring information on a world-wide standard which defines contents that should be described in said application. However, ZipForm does teach to get information at jurisdictional level [ZipForm page 22]; and also ZipForm teaches Data Template [page 12]. In addition, Gajraj teaches A generic standard for DTDs is called Standard Generalised Markup Language (SGML) [Gajraj, 0004]. It is known to one of ordinary skill in the art that SGML is a device-independent, system-independent methods of representing texts in electronic form.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify ZipForm as taught by Gajraj to have a standard format from which data is to be converted to a custom format. For example, it is known to one of ordinary skill in the art at the time the invention was made that Data Interchange Format (aka DIF) was one of the world standard format to transform data from first document (MS Excel) to second document (Lotus 123).

ZipForm in view of Gajraj teaches:

acquiring information on a standard unique to each country which is defined in detail in conformity to said world-wide standard (transforming a first document marked up according to a first document type definition, into a second document marked up

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according to a second document type definition) [Gajraj, 0014], and information on published applications and examinations unique to each country (teaches to acquire information from plurality of documents for plurality of jurisdiction) [ZipForm page 18, set for form for South Dakota Area and Kokomo Area];

accepting conditions associated with the application documents to be prepared and accepting a selected country, wherein the conditions (e.g. contract, listing, leasing) and the country (e.g. county, state) are specified by a user; and

ZipForm in view of Gajraj does not teach assisting to prepare application. However, Broadbent teaches assisting to prepare application [Broadbent, Fig. 7-12, 33 and disclosure associated with Fig. 7-12, 33]

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify ZipForm in view of Gajraj as taught by Broadbent to use the Federal, State, local and professional regulations and requirements and implementing instructions to generate a plurality of tasks which can be used to control and drive the process of handling an application.

ZipForm in view of Gajraj and Broadbent teaches:

capability to prepare documents based on said acquired information on the world-wide standard, information on the standard unique to each country acquiring information on a standard unique to each country which is defined in detail in conformity to said world-wide standard (transforming a first document marked up according to a first document type definition, into a second document marked up according to a second document type definition) [Gajraj, 0014], and information on the application,

examination, and conditions associated with the application documents [ZipForm in view of Gajraj, 0014].

examining application documents to check whether any of application documents include an item which violates examination criteria [Broadbent, abstract, Fig 7-12 and disclosure associated with Fig. 7-12].

preparing and converting the application documents for selected country (jurisdiction) to comply with examination conditions in said country (jurisdiction) so that none of the documents include violation of examination criteria (Broadbent teaches to use Federal, State, local and professional regulations and requirements and implementing instructions to generate a plurality of tasks which can be used to control and drive the process of handling a mortgage loan application, another example of examining the documents to prevent violation of a authority like a jurisdiction) [Broadbent, abstract].

Regarding claim 4, ZipForm in view of Gajraj and Broadbent teaches electronically submitting the prepared application documents to perform electronic application processing.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over ZipForm (document labeled as Information on ZipForm) in view of Gajraj US Publication 2002/0002566 and further in view of Broadbent et al. US Patent 6,904,412 hereinafter

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known as Broadbent and Abbruzzese et al. US Patent 5557515 hereinafter known as Abbruzzee.

Regarding claim 5, ZipForm in view of Gajraj and Broadbent does not teach recording an entire manipulation procedure of an operator for preparing an application with the assistance of application preparation as log information so that the log information can be viewed at a later time. However, Abbruzzese teaches an electronic activity log function maintains a record of key activities involved in the processing of work items [abstract].

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify ZipForm in view of Gajraj and Broadbent as taught by Abbruzzese to automatically and securely maintain a record of the activities of all staff members in work processing.

Allowable Subject Matter

Claims 3 and 8 are deemed allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Conclusion

Applicant is required under 37 CFR '1.111 (c) to consider the references fully when responding to this office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naresh Vig whose telephone number is (571) 272-6810. The examiner can normally be reached on Mon-Thu 7:00 - 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Naresh Vig
Examiner
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March 19, 2007